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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,124	11/14/2003	Vasanth R. Tovinkere	81674-306504	9930

7590 09/08/2006  
Roger R. Wise  
PILLSBURY WINTHROP LLP  
Suite 2800  
725 South Figueroa Street  
Los Angeles, CA 90017-5406

EXAMINER

STARKS, WILBERT L

ART UNIT	PAPER NUMBER
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2129

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/714,124

**Applicant(s)**

TOVINKERE ET AL.

**Examiner**

Wilbert L. Starks, Jr.

**Art Unit**

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-17,30-36,38-50 and 52-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-17,30-36,38-50 and 52-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 15-17, 30-36, 38-50, and 52-56 have been examined.

Examiner commends Applicant in his attempt to amend the claims. Examiner has one remaining quibble with the claims that is trivial at this point, but it is enough to trigger the rejections of the claims. Specifically, the result of the calculations at the end of the claims is not claimed to come out of the computer to do anything. Examiner will elaborate further in the following action.

#### ***Claim Rejections - 35 U.S.C. §101***

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the invention as disclosed in claims 15-17, 30-36, 38-50, and 52-56 is directed to non-statutory subject matter.

2. None of the claims is limited to practical applications. Specifically, the Federal Circuit held the following:

Today we hold that *the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price*, constitutes a practical application of a mathematical algorithm, formula, or calculation because it produces 'a useful, concrete and tangible result' -- *a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.* (emphasis added) *State Street Bank* at 1601.

3. The court was careful to specify that the "useful, concrete and tangible result" it found was "a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." (i.e. the trading activity is the further practical use of the real world monetary data beyond the transformation in the computer – i.e., "post-processing activity".)

4. at the end of Applicant's claims, Applicant cites no such specific results to define a useful, concrete and tangible result. Applicant claims temporal event detection, but does not use that unit for anything outside the computer...the way the Federal Circuit described in State Street as illustrated above. Claims 15-17, 30-36, 38-50, and 52-56 are, thereby, rejected under 35 U.S.C. §101.

5. In light of Applicant's previous amendments, this seems to be an easy thing to correct and Examiner looks forward to Applicant's amendment to that effect.

### ***Claim Rejections - 35 U.S.C. §112***

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 15-17, 30-36, 38-50, and 52-56 are rejected under 35 U.S.C. §112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a §101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed *how* to practice the *undisclosed* practical application. This is how the MPEP puts it:

("The how to use prong of section 112 **incorporates as a matter of law** the requirement of 35 U.S.C. §101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. §101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. §112."; In re Kirk, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) ("Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, **otherwise an applicant would anomalously be required to teach how to use a useless invention.**") See, MPEP 2107.01(IV), quoting In re Kirk (emphasis added).

Therefore, claims 15-17, 30-36, 38-50, and 52-56 are rejected on this basis.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. Goldman (U.S. Patent Number 5,751,911 A; dated 12 MAY 1998; class 706; subclass 020) discloses real-time waveform analysis using artificial neural networks.

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- B. Hansen et al. (U.S. Patent Number 5,640,490 A; dated 17 JUN 1997; class 704; subclass 254) discloses a user independent, real-time speech recognition system and method.
- C. Shinohara et al. (U.S. Patent Number 5,619,619 A; dated 08 APR 1997; class 706; subclass 028) discloses an information recognition system and control system using same.
- D. O'Hagan et al. (U.S. Patent Number 5,581,658 A; dated 03 DEC 1996; class 706; subclass 020) discloses an adaptive system for broadcast program identification and reporting.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Wilbert L. Starks, Jr. whose telephone number is (571) 272-3691.

Alternatively, inquiries may be directed to the following:

**S. P. E. David Vincent** (571) 272-3080

**Official (FAX)** (571) 273-8300

WLS

04 September 2006



Wilbert L. Starks, Jr.  
Primary Examiner  
Art Unit - 2121